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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,891	10/12/2004	Aiichiro Takahashi	2004-10-12	5890
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ShenLaw Firm 36-40 Main St. Suite 306 Flushing, NY 11354			EXAMINER VANDERHORST, MARIA VICTORIA	
			ART UNIT 3688	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,891

Applicant(s)

TAKAHASHI, AIICHIRO

Examiner

M. VICTORIA VANDERHORST

Art Unit

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 10/12/2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

This communication is in response to application No. 10/711,891, filed on 10/12/2004.

Claims 1-32 are currently pending and have been examined.

Claims 1-32 have been rejected.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. **As to claim 1 and 13**, the paragraph "receiving third information from said advertiser, said third information being used to define advertising information and the appearance of said advertising information within said first advertising box ". It is not

clear. In the specification, in page 6, third paragraph, it seems that the ad viewer is receiving third information. It is not clear who is receiving the third information if the ad viewer or the advertiser computer. Critical or essential subject matter to the practice of the invention, but not included in the claim(s) is generating lack of clarity.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 13, 19-24, 28 and 32 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 13, the claim is deficient because the phrases "optionally" and "any" which render the claim indefinite. The use of the mentioned phrases does not permit particularly point out and distinctly claim the subject matter of the invention. The claim recitation is confusing and ambiguous. For examination purposes, the examiner has constructed the claim without the phrases "optionally" and "any".

As to claim 19-24, the claims are deficient because the phrase "method of" which render the claim indefinite. The claims depend from system claim 14 but they recite method steps.

As to claim 28 and 32, they contain the acronym "RSS". Acronyms must be defined in plain terminology within the claim before the acronym can be used. The term

"RSS" is also not defined anywhere in the specification. The examiner interprets the acronym "RSS" as meaning rich site summary as known in the art.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1-32, are rejected 35 U.S.C. 103(a) as being unpatentable over US Patent 6,012,071 Krishna in view of US Patent 6,587,127 Leeke et al.

As to claim 1, Krishna discloses an online advertising method and system, comprising: (a) receiving first information from an advertiser, said first information being used to request an advertising box, wherein said advertising box is an area where said advertiser is able to enter advertising information and design the appearance of said advertising information (**Krishna discloses a design and layout tool to create and define regions in a web page (electronic publication). This tool provides capability to a publisher to include advertising space on the web pages (Col. 1:19-55, Col. 5:5-20). Also the tool provides instructions to a viewer (a viewer is a**

program application engine) to obtain formatting information to be displayed,

Abstract, Fig. 1, Col. 7:25-27, Col. 7:46-67, Col. 8:1-5);

(b) transmitting second information to said advertiser, said second information enabling said advertiser computer to display first advertising box (**Krishna discloses that the publisher or page designer (who works for the advertiser) creates and updates web pages including advertisement using the tool, Col. 1:55-67, Col. 2:1-7**);

(c) receiving third information from said advertiser, said third information being used to define advertising information and the appearance of said advertising information within said first advertising box (**Col. 4:10-36**);

Krishna teaches that a viewer, that is a program application engine, can locate and display information as directed by the formatting instructions (**Col. 4: 27-36**).

Krishna does not disclose (d) transmitting fourth information to an ad viewer computer, said fourth information enabling said ad viewer computer to display second advertising box and utilize said appearance of said advertising information to deploy said advertising information within said second advertising box.

However, Leeke teaches transmitting information to an ad viewer computer (server interacting with user's computer), then enabling an ad viewer computer to deploy information according to format and appearance of said advertising information (**Leeke's system has an advertisement component and a customer profile component that work to modify the content rendered by the content delivery**

component, Abstract, Fig. 1, Col. 7:10-15, Col. 4:31-49, Col. 6:3-10, Col. 7:10-16, Col. 7:17-31).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Leeke's teaching into the system of Krishna in order to facilitate the design and deployment of online advertisement by the advertiser or publisher and to promote displaying of advertising according to the ad viewer preferences and profile.

As to claim 13, it contains limitations already addressed in claim 1. Further, regarding to the limitation (c), selects an existing advertising information associated with said advertiser if available; renders said existing advertising information and the appearance of said existing advertising information if available to said advertiser computer and utilizes said appearance of said advertising information to deploy said advertising information within second advertising box (**Fig. 1, Col. 7:25-27, Col. 7:46-67, Col. 8:1-5, Col. 1:19-55, Col. 5:5-20, Col. 4:10-36).**

See the discussion of claim 1, the claim is rejected in like manner.

As to claim 2, Krishna and Leeke disclose the method as in claim 1 above. Further, Krishna discloses a system wherein said second information further comprises an editing tool to enable said advertiser to modify advertising information within said first advertising box (**Abstract, Col. 6:27-59).**

As to claim 14, Krishna and Leeke disclose the method as in claims 13. Further, Krishna discloses a system comprising an editing tool that is delivered to said advertiser computer with said first advertising box and said second advertising box, wherein said editing tool enables said advertiser to modify advertising information within said first advertising box and said second advertising box (**Abstract, Col. 6:27-59, Krishna's tool has capability to duplicate boxes in the editing area of the tool, Fig 1, Col. 7:46-61**).

As to claim 3 and 19, Krishna and Leeke disclose the invention substantially as claimed, see the discussion of claims 2 and 14 above. Further, Krishna discloses a system that allows to change advertising contents (**Col. 4:37-50, Col 5:5-20**) and said second advertising box (**Krishna's tool has capability to duplicate boxes in the editing area of the tool, Fig 1, Col. 7:46-61, Col. 4:37-50, Col 5:5-20**).

As to claim 4 and 20, Krishna and Leeke disclose the method as in claims 2 above and 14. Further, Krishna discloses that his system allows changing advertising objective (**in Krishna's system, the page designer can create a webpage where each client displays different information (depending of the audience), Col. 5:21-42**) within said first advertising box and said second advertising box (**Krishna's tool has capability to duplicate boxes in the editing area of the tool, Fig 1, Col. 7:46-61, Col. 5:21-42**).

As to claim 5 and 21, Krishna and Leeke disclose the method as in claims 2 and 14 above. Further, Krishna discloses that his system allows changing localization of advertising contents (**Krishna's system allows to modify the position of advertisement in the web page, Col. 6:27-45, Col. 5:5-20**) within said first advertising box and said second advertising box (**Krishna's tool has capability to duplicate boxes in the editing area of the tool, Fig 1, Col. 7:46-61, Col. 6:27-45, Col. 5:5-20**).

As to claim 6 and 22, Krishna and Leeke disclose the method as in claims 2 and 14 above. Further, Krishna discloses that his system identifies one or more templates that are associated with said first advertising box (**Col. 8:6-24, Col. 7:46-61**) and said second advertising box (**Krishna's tool has capability to duplicate boxes in the editing area of the tool, Fig 1, Col. 7:46-61, Col. 8:6-24, Col. 7:46-61**).

As to claims 7 and 15, Krishna and Leeke disclose the method as in claims 2 and 14 above. Krishna and Leeke do not disclose a system wherein said editing tool is executed independently of operating system platforms.

However, Official Notice is taken that is common practice to have computer software implementations which can be made to work on multiple computer platforms, "Cross-platform" or "multi-platform".

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the teaching of Krishna and Leeke with commonly recognized practice of design and implement software that is able to be run on more

than one computer platform in order to provide portable and scalable tools to the advertisers and the ad viewers (users).

As to claims 8 and 16, Krishna and Leeke disclose the method as in claims 7 and 15 above. Further, Krishna discloses a system wherein said operating system platforms include a computer device (**Abstract**) (IBM-PC, Apple Macintosh, Tablet PC, etc.), a phone device (**Krishna's system is communicating with the server over the networks. The communication can be over phone lines, cable or fiber optic, Col.1:11-16**), or other devices running an HTML-capable viewer (**Krishna's system runs in web site client computer systems, Abstract**).

Krishna does not disclose a hand-held device (PDA, Palm, etc.).

However, Leeke teaches a hand-held device (PDA, Palm, etc.) (**Col. 4:21-30**).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Leeke's teaching into the system of Krishna in order to provide convenient design tools for the advertisers, publishers and ad viewers to use and carry around with them.

As to claim 9 and 17, Krishna and Leeke disclose the method as in claims 8 and 16 above. Further, Krishna discloses a system wherein said HTML-capable viewer includes Internet Explorer, Netscape, Opera and other web browsers, which are JavaScript-enabled (**Col. 7:25-45, Col. 1:56-67, Col. 2:1-7**).

As to claim 10 and 18, Krishna discloses the invention substantially as claimed, see the discussion of claims 7 and 17 above. Further Krishna teaches that his system is built in Java applet. Krishna does not specifically disclose a system wherein said editing tool is written in JavaScript.

However, Official Notice is taken that Java and JavaScript are both programming languages. Moreover, JavaScript programs can communicate with Java Applets.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine Krishna's applet functionality with JavaScript language since both languages are used for enhancing the capabilities of web pages.

As to claims 11, 12, 23 and 24, Krishna and Leeke disclose the method as in claims 1, 2, 13 and 14 above. Further, Krishna discloses a system wherein said advertising information includes advertising objective, texts, pictures, movie clips, flash and html links (Col. 4:10-36, Col. 7:62-67, and Col. 8:1-5).

As to claims 25 and 29, Krishna and Leeke disclose the method as in claims 13 and 14 above. Krishna does not disclose that his system further comprises a viewing process system that (a) receives a set of querying criterions from an ad viewer computer; (b) selects ads containing advertising information in accordance with said querying criterions; and then (c) delivers said ads to said ad viewer computer and renders said ad viewer computer to display said ads.

However, Leeke discloses a system further comprising a viewing process system that

(a) receives a set of querying criterions from an ad viewer computer (Col 29:30-37);

(b) selects ads containing advertising information in accordance with said querying criterions (Col. 10:44-49); and then

(c) delivers said ads to said ad viewer computer and renders said ad viewer computer to display said ads (Col. 7:10-16, Fig. 1, Col. 47:37-67, Col. 48:1-24).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Leeke's teaching into the system of Krishna in order to provide capability that supports the ad viewer with user-specific content based on his/her preferences and profile.

As to claims 26 and 30, Krishna and Leeke disclose the method as in claims 25 and 29 above. Krishna does not disclose that his system further comprising an ad viewer authorization system that (a) receives a request from an ad viewer; (b) retrieves a set of querying criterions associated with said ad viewer.

However, Leeke discloses a system further comprising an ad viewer authorization system that (a) receives a request from an ad viewer (Leeke's system has a profile component and an advertising component (Col. 6:3-10). The customer profile component ensures that each user has a login, customer ID (Col. 6:11-56)); (b) retrieves a set of querying criterions associated with said ad viewer

(Leeke's system has a profile component and an advertising component (Col. 6:3-10). His system has audible and visible advertisements (Col. 7:10-16). The advertising component of his system can determine and associate advertisement target to each user (Col. 48:15-24). An ad viewer can select advertisement by content along with other information such as audio (Col. 10:44-49). Behind scenes, Leeke's system maintains a database of advertisement records (Col. 47:37-67, Col. 48:15-24)).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Leeke's teaching into the system of Krishna in order to provide capability that support the ad viewer with user-specific content along with unique login to ensure access to his/her preferences providing an interesting and easy to use interface for each user.

As to claims 27 and 31, Krishna and Leeke disclose the method as in claims 26 and 30 above. Krishna does not disclose a system wherein said querying criterions are stored in a server where said authorization system is.

However, Leeke discloses a system wherein said querying criterions are stored in a server where said authorization system is **(Col. 6:11-28)**.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate Leeke's teaching into the system of Krishna in order to provide capability that support the ad viewer with user-specific content along with

unique login to ensure access to only his/her preferences providing personalized content and maintaining the user's interest.

As to claim 28 and 32, Krishna and Leeke disclose the method as in claims 26 and 30 above. Further, Krishna discloses a system comprising a RSS feed generating system that produces RSS feed in accordance with said querying criterions (**Col. 4:37-67, Col. 5:1-20**).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
9. Matthews (7,284,208) discloses a method to view a user document with content from different sources.
10. Clarke (7,062,453) provides content management server, advertisements and menu items with database capability.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. VICTORIA VANDERHORST whose telephone number is (571)270-3604. The examiner can normally be reached on regular.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571 272 6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. V./
Examiner, Art Unit 3688

/Raquel Alvarez/
Primary Examiner, Art Unit 3688